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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,028	06/27/2001	Paul Karlstedt	975.340USW1	5698

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EXAMINER

CHO, UN C

ART UNIT PAPER NUMBER

2617

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/893,028	<b>Applicant(s)</b> KARLSTEDT ET AL.	
	<b>Examiner</b> Un C. Cho	<b>Art Unit</b> 2687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-20, 27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-26 and 29-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 21, 22 and 29 – 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Jyogataki et al. (US 6,477,383 B1).

Regarding claim 21, Jyogataki discloses a method for generation and transmission of messages in a mobile telecommunication network, comprising the steps of: monitoring the location of a mobile subscriber terminal within the

mobile telecommunications network using location information generated by, and available for said network, said monitoring being effected by repeatedly retrieving data corresponding to the location of said mobile subscriber terminal from a location register of the network (server (Fig. 1, 5) monitors the location of the mobile terminal; Jyogataki, Col. 8, lines 32 – 38); comparing the monitored location with a predetermined location within said network; judging, whether the monitored location corresponds to said predetermined location; if the result of judging is positive, sending a predetermined voice or data message form said network to another terminal, wherein said another terminal is a predetermined subscriber terminal (Jyogataki, Col. 7, line 46 through Col. 8, line 16 and see Fig. 4 and 5); and defining said predetermined terminal as a terminal which has issued a request for a value added service (PHS terminal PS1 is the terminal which has issued a recall mode request to find out the status of PHS terminal PS2; Jyogataki, Col. 8, lines 39 – 41 and 47 – 65).

Regarding claim 22, Jyogataki discloses wherein said data message is a SMS message (an SMS message by definition is alphanumeric characters being transmitted from a network or from another mobile unit to the mobile unit and Jyogataki clearly discloses that the server transmits a character message to the mobile unit; Jyogataki, Col. 8, lines 8 – 14).

Regarding claim 29, Jyogataki discloses wherein said request contains at least an identification of said predetermined terminal and a location information for said predetermined terminal (recall mode recall data contains at least an

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identification of said predetermined terminal and a location information for said predetermined terminal; Jyogataki, Col. 7, lines 29 – 34).

Regarding claim 30, Jyogataki discloses further comprising a step of defining said predetermined location based on said location information for said predetermined terminal (Jyogataki, Col. 7, line 58 through Col. 8, line 7).

Regarding claim 31, Jyogataki discloses wherein said location information available for said network is cell information (service area of a public base station; Jyogataki, Col. 8, lines 1 – 7).

Regarding claim 32, the claim is interpreted and rejected for the same reason as set forth in claim 30.

Regarding claims 33 and 34, the claims are interpreted and rejected for the same reason as set forth in claim 21.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 23 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jyogataki in view of Stenman et al. (US 6,223,029).

Regarding claim 23, Jyogataki as applied above does not specifically disclose wherein said data message contains data for remotely controlling

equipment assigned to said another terminal. In an analogous art Stenman discloses wherein said data message contains data for remotely controlling equipment assigned to said another terminal (Stenman, Col. 7, lines 49 – 52). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Stenman to the system of Jyogataki in order to provide the mobile station with dual functionalities so that it is able to provide normal telephony functions and act as a remote control unit for a variety of peripheral devices accessible through some type of local area communication system or related communication system.

Regarding claim 24, the claim is interpreted and rejected for the same reason as set forth in claim 23.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jyogataki in view of Syed et al. (US 6,038,451).

Regarding claim 25, Jyogataki discloses that the mobile terminal performs registration with a public base station (Jyogataki, Col. 8, lines 32 – 38). However, Jyogataki does not specifically disclose wherein said location register is a home location register and in said home location register a record of the location of each subscriber terminal present within the range of an associated mobile services switching center is kept. In an analogous art, Syed discloses that the home location register has record of the location of each mobile unit present within the range of an associated mobile services switching center is kept (Syed,

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Col. 4, lines 63 – 67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Syed to the system of Jyogataki in order to provide a location based call forwarding service that works transparently to the subscriber, without requiring any user interaction to activate or deactivate the service.

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jyogataki in view of Brennan et al. (US 5,329,578).

Regarding claim 26, Jyogataki as applied above does not specifically disclose that the message is transmitted only within a predetermined time range. In an analogous art, Brennan discloses that a predetermined message is transmitted only within a predetermined time range (Brennan, Col. 6, lines 53 – 64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Brennan to the system of Jyogataki in order to provide a personal communication system which can be easily integrated with a network and be able to offer incoming call management and communication mobility while making use of the network based features.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 21 – 26 and 29 – 34 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Un C. Cho whose telephone number is (571) 272-7919. The examiner can normally be reached on M ~ F 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Un C Cho  
Examiner  
Art Unit 2687

3/16/06 *UC*

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER